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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FORD, JOHN M

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/17/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/440138

Applicant(s)

Fitzgerald

Examiner

JMFord

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on May 20, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 — 10 and 13 is/are pending in the application.
- Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 — 8 and 13 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

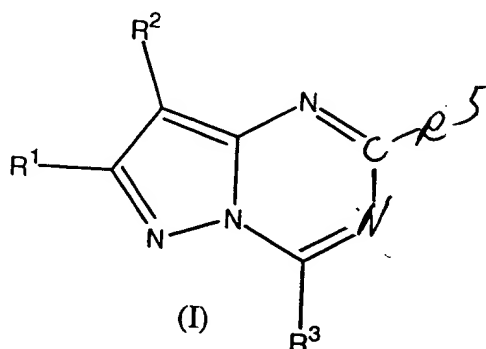
Office Action Summary

Art Unit: 1624

Applicants response of May 20, 2002 is noted.

The claims now in the application are claims 1--10 and 13.

Applicants elected Group II, the instances where A is CR5 and B is N, the symmetrical triazines, i.e.



Working on the entire application would be a serious burden, as the examiner is not given the time to search differently classified inventions.

Claim 1, as written, is an example of an improper Markush Claim, i.e. a reference for one ring system is not a reference for the other. That is the yard stick as to when to require restriction.

Footnote 3 of In re Weber 198 USPQ 330, provides in col. 1 that:

“A Markush-type claim is directed to “independent and distinct inventions,” if two or more of its members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render claim obvious under 35 U.S.C. 103 with respect to the other member(s).”

Art Unit: 1624

“If the claim is of the nature, the examiner is authorized to reject it as an improper Markush claim, and for misjoinder, and to require the applicant to restrict the application to a single invention. In making such a requirement, the examiner will (1) clearly delineate the members or groups of members believed to constitute improperly joined inventions, and (2) state reasons fully explaining why they are independent and distinct. Applicant’s response to such a requirement should be an election of a single adequately disclosed and supported invention, with or without restriction of the claim(s) to that invention. Of course, the response must not introduce new matter into the application. See 35 U.S.C. 132 and *In re Welstead*, 59 CCPA 1105, 463 F.3d 1110, 174 USPQ 449 (1972). A refusal to elect a single invention will be treated as a non-responsive reply.

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner is encouraged to examine it on the merits, even though it is directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure outlined in the preceding paragraph and will not require restriction.”

Here, there is extreme burden to expand the search beyond the elected invention, as those variations would control the search in other unsearched area, and the search would have to be rerun with expanded parameters, at additional expense. The examiner is not given the time to search more than invention, as noted.

Further, in *In re Weber*, 198 USPQ 330 at col. 2.

Art Unit: 1624

“Where the examiner has rejected the claim, and required restriction, and the applicant has responded, without restricting, the claim(s) to a single invention, the examiner shall, if the position is adhered to, again reject the claim and any other Markush claims not restricted to the elected invention.

No further examination of these claims is required unless and until such rejection has been overcome. However, if the search of the single elected invention develops prior art which would render both the elected invention and the improper Markush claim(s) unpatentable, such prior art may be applied in rejections of both, without a complete search of the subject matter of the improper Markush claim(s). Otherwise, only true generic claims and those restricted to the elected invention will be examined in the usual manner.”

Claim 1 constitutes an improper joinder of inventions as it groups together inventions that are distinct and separately classified, and will support separate patents. Ex parte Markush, 1925 C.D. 126, provided for this claim structure where there was an emergency engendered need as the substances were “so closely related that they would not support a series of patents”. This is not the case here. Therefore, the instant generic claim constitutes an improper joinder of inventions; Ex parte Reid, 105 U.S.P.Q. 251; In re Winnek, 73 U.S.P.Q. 225; In re Ruzicka, 66 U.S.P.Q. 226.

Claim 1 need be redrawn to the elected invention, solely.

Same, claims 2 and 3.

Art Unit: 1624

A multiple dependent claim may not be dependent on a multiple dependent claim; 35 U.S.C. 112, 5th paragraph. Therefore, claims 1--6 and 8 are rejected under 35 U.S.C. 112, 5th paragraph.

Claims 9 and 10 stand withdrawn, as being directed to non-elected subject matter.

Note MPEP 2173.05 (h):

“Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.”

It appears the compounds listed on page 103 and top of p. 104 are being excluded from claim 1.

Applicants cannot successfully argue unity of invention while removing certain compounds.

What is the propose of removing the compounds? See New Rule 105.

Are there prior art compounds?

The next adjacent compounds to those removed by exception would be obvious therefrom; In re Nomiya et al., 184 USPQ 607, provides that where certain compounds are removed from the genus, it is a reasonable assumption that those compounds are in the prior art.

Assuming those compounds removed are in the prior art, the next adjacent compounds to those removed would be obvious therefrom.

Art Unit: 1624

We reject on compounds, not their citations.

The next adjacent compound would be structurally obvious. See, *In re Dillon*, 919 F.2d at 696, 16 U.S.P.Q. 2d at 1904. See also *Deuel*, 51 F.3d at 1558, 34 U.S.P.Q. 2d at 1214 (“Structural relationships may provide the requisite motivation or suggestion to modify one compound to obtain another compounds. For example, one compound may suggest its homologs, because homologs often have similar properties, and, therefore, chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties, or merely to satisfy their production goals.

Other structural similarities have been found to support a prima facie case of obviousness. E.g., *In re May*, 574 F.2d 1082, 1093-95, 197 U.S.P.Q. 601, 610-11 (CCPA 1978) (stereo isomers); *In re Wilder*, 563 F.2d 457, 460, 195 U.S.P.Q. 426, 429 (CCPA 197) (adjacent homologs and structural isomers); *In re Hoch*, 428 F.2d 1341, 1344, 166 U.S.P.Q. 406, 409 (CCPA 1970) (acid and ethyl ester); *In re Druey*, 319 F.2d 237, 240, 138 U.S.P.Q. 38, 41 (CCPA 1963) (omission of methyl group from pyrazole ring).

A compound need not be a homolog or isomer of a prior art compound in order to be susceptible to a rejection based on structural obviousness.

Thus, a difluorinated compound was held unpatentable over the prior art di chloro compound on the basis of analogical reasoning. Ex parte Wiseman (POBA 1953) 98 U.S.P.Q. 277.

Art Unit: 1624

Claims 1--8 and 13 are rejected under 35 U.S.C. 102/103 as being unpatentable over U.S. Patents 3,910,907. Compare claim 1 of each.

Claim 1 is rejected under 35 U.S.C. 112, 2nd and 1st paragraph, as a result of the lines at the top of page 97:

“or R2c and R2d may join to form a heterocyclic ring having 0-3 heteroatoms selected from O, N or S.”

The size of the ring and placement of the hetero atoms in the unknown rings is not specified. The number of combinations possible, even with 1--3 atoms selected for O, N and S is quite large.


Adjacent O/S or S/S or O/O combinations are notoriously unstable.

This type of hetero expression was held unclear in *In re Wiggins*, 179 USPQ 421 ~~423~~ (CCPA 1973). *Wiggins* was favorably cited in *In re Oetiker* 23 USPQ (2nd) 1661 at 1662, col. 2.

Applicants are claiming rings that have not been made, yet. What is the source of the starting materials for the hetero rings claimed?

John M. Ford:jmr

July 16, 2002


JOHN M. FORD
PRIMARY EXAMINER
